

Appl. No. 10/765,423
Atty. Docket No. 9150
Amdt. dated October 3, 2006
Reply to Office Action of August 18, 2006
Customer No. 27752

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REMARKS

Status of the Claims

Claims 1 and 3-20 are pending in the present application. Claim 2 has been canceled for reasons unrelated to patentability. No additional claims fee is believed to be due.

Rejection Under 35 U.S.C. § 103(a) Over U.S. Patent No. 5,534,265 to Fowler et al.

Claims 1-20 are finally rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,534,265 to Fowler et al. ("Fowler"). The Office Action asserts that Fowler teaches a non-abrasive personal cleansing aqueous gel composition comprising (a) from about 0.1% to about 20% of insoluble particles, (b) from about 0.05% to about 10% of a water soluble or dispersible gelling agent, and (c) from about 20% to about 99.85% water. The Office Action admits that Fowler does not teach a composition comprising irregularly shaped and spherical particles having a weight ratio and median sizes. However, the Office Action asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have prepared personal care compositions comprising a mixture of irregularly shaped particles and spherical particles in their optimum proportions because Fowler teaches that particles having a wide range of shapes can be utilized. Applicants traverse the present rejection based on the following comments.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences *themselves* would have been obvious, but whether the claimed invention *as a whole* would have been obvious. Accordingly, a patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. See *MPEP* at § 2141.02. The Office Action asserts that because col. 1, lines 7-9 of Fowler teaches that a personal care composition comprising micronized cleansing particles is useful for cleansing the skin and hair, that routine experimentation would have led one of ordinary skill in the art to Applicants' claimed invention. However, the particles in Fowler are directed specifically to a cleansing benefit. In fact, at col. 3, line 34, Fowler calls the particles, "cleansing particles." Therefore, Fowler does not address the problem of

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improving volume, body and fullness as taught by Applicants. *See the written description* at page 2, lines 23-26.

Furthermore, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *See MPEP* at § 2143.01. Fowler only teaches that particles having a size greater than about 75 microns are tactilely perceivable and that particles of less than about 1 to about 5 microns are generally less effective for providing a cleansing benefit. *See Fowler* at col. 3, lines 26-33. Therefore, Fowler only provides a motivation to modify particle size in order to optimize cleansing performance. In contrast, Fowler does not teach or suggest that any benefit is achieved by formulating specific shapes or sizes, or combinations of shapes and sizes of particles in its compositions. Therefore, Fowler provides no motivation to one of ordinary skill in the art to optimize particle proportions, because Fowler fails to teach or suggest any correlation between particle proportion optimization and *any* benefit whatsoever.

Fowler does not teach or suggest each and every limitation of Applicants' claimed invention. Therefore, Claims 1 and 3-20 are not rendered *prima facie* obvious over Fowler.

CONCLUSION

In light of the remarks presented herein, it is requested that the Examiner reconsider and withdraw the present rejections. Early and favorable action in the case is respectfully requested.

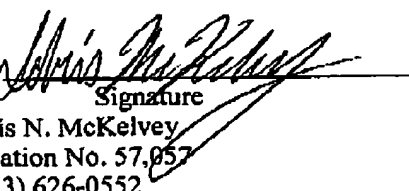
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Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application and allowance of Claims 1 and 3-20.

Respectfully submitted,

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By


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